

Remarks

Claims 1-24, 26-34, 52-59 and 65-71 are pending in the present application. Claims 25, 42, and 60-64 were withdrawn from consideration and are hereby cancelled. Reconsideration is respectfully requested.

Noted Typographical Error

As noted by the Examiner, there was a typographical error in the statement that claim 52 was cancelled. Claim 52 is, as the Examiner commented, pending in this application. This error is corrected in the present amendment. Applicants thank the Examiner for noticing the typographical error and bringing it to our attention.

Claim Rejections Under 35 USC § 102(e)

Claims 1-9, 11, 16-22, 26-27, 31-34, 52-59 and 65-71 are again rejected under 35 USC § 102(e) as allegedly being anticipated by Miki (US Pat. No. 6,325,081). Applicants traverse this rejection.

Regardless of the fact that there is a continuation-in-part in the priority chain of the present application, because all of the features of all of the claims of the present application are supported by the grandparent patent and the great grandparent PCT application, the priority date for the claims at issue is at least as early as March 15, 1999 (the PCT application filing date).¹ As stated by the Examiner on page 11 of the Office action dated February 14, 2006, the Miki reference 102(e) effective date is May 17, 1999.

The Examiner expresses his belief that Miki is prior art because of the present application is a divisional of parent application USP 6,632,292, which is a continuation-in-part of, *inter alia*, USP 6,413,436. The Examiner states that because the '292 parent is a CIP, under MPEP § 2133.01, the effective date for the CIP is the filing date of the CIP. The Examiner is incorrect. As also recited by the Examiner, MPEP § 2133.01 states that the CIP filing date is the effective date when the claims "are not supported by the parent application." However, the claims as recited in the present application are supported by the parent '292 patent (from which the present claims were divided) as well as supported the grandparent '436 patent from which '292 claimed priority as a CIP and is supported by

¹ Although the priority date for the present application claims likely goes back at least as far as the provisional application filed on January 27, 1999 (60/117,474), the benefit of which the '436 grandparent patent claims priority, because the March 15, 1999 date predates the Miki reference at issue, there is no need to examine the support for the earlier priority dates.

the great-grandparent PCT application (PCT/US99/05674). The '436 patent (filed Nov. 10, 1999) is a straight continuation of International Patent Application No. PCT/US99/05674 *filed March 15, 1999*.

This March 15, 1999 priority date thus applies to the present claims and pre-dates the Miki reference.

The present claims have priority that dates back much further but it is unnecessary to explain such to predate the cited Miki reference. In sum, Applicants note that the parent patent (6,632,292) is a CIP of the grandparent patent (6,413,436), which is a continuation of the PCT application PCT/US99/05674. A review of the published PCT application as well as the grandparent patent shows that the presently claimed subject matter was disclosed in each of those priority documents and thus the claim of priority to at least as early as March 15, 1999, is proper.

Support in the Parent and Grandparent Patents from Which the Present Claims Claim Priority

As a divisional of the '292 patent, clearly, there is support in the parent application. We provide examples of such support in the grandparent, US patent '436 and its parent PCT (International Patent Application No. PCT/US99/05674) (the great-grandparent application) of which the '436 patent is a continuation, as follows:

Claim 1 - supported throughout the '436 patent such as at col. 2, ll. 28-42; col. 4, ll. 38-49; col. 5, ll. 58-62; col. 6, ll. 6-19; etc.

Claim 2 - same as claim 1 and col. 7, ll. 23-30.

Claim 3 - same as claims 1 and 2.

Claim 4 - same as claims 1 and 2.

Claim 5 - same as claims 1 and 2.

Claim 6 - same as claim 1 and col. 6, ll. 6-19; col. 5, ll. 23-25.

Claim 7 - same as claim 1 and col. 6, ll. 14-19.

Claim 8 - same as claim 1 and col. 6, ll. 20-39.

Claim 9 - same as claim 1 and col. 6, ll. 22-32.

Claim 11 - Note that Miki does not disclose an HF/ozone etchant. The portion of Miki cited by the Examiner (i.e., col. 9, ll. 55-56) are disclosing ozone washing solutions in order to allow the delivery of ultra-pure water for removal of particles.

Claim 13 - same as claim 1 and col. 6, ll. 20-39.

Claim 14 - same as claim 1 and col. 6, ll. 34-39.

Claim 15 - same as claim 1 and col. 6, ll. 34-39.

Claim 16 - same as claim 1 and col. 4, ll. 21-25.

Claim 17 - same as claim 1 and col. 5, ll. 48-55.

Claim 18 - same as claim 1 and col. 4, ll. 37-49.

Claim 19 - same as claim 1 and col. 4, ll. 21-25.

Claim 20 - same as claim 1 and col. 4, ll. 16-33.

Claim 21 - same as claim 1 and col. 4, ll. 16-33.

Claim 22 - same as claim 1 and col. 4, ll. 16-33.

Claim 23 - same as claim 1 and col. 6, ll. 6-19.

Claim 24 - same as claim 1 and col. 6, ll. 6-19.

Claims 26-28 recite in different combinations the features of the above claims and are supported in the same manners as the above claims in the parent and grandparent patents.

Claims 29 and 30 - same as claim 1 and col. 1, line 55 - col. 2, line 8. In addition, Applicants note that the Examiner asserts (office action page 10) that one of ordinary skill in the art would have found it obvious to remove cobalt contaminants.

Claims 31-34 recite in different combinations the features of the above claims and are supported in the same manners as the above claims in the parent and grandparent patents.

Claims 53-59 recite in different combinations the features of the above claims and are supported in the same manners as the above claims in the parent and grandparent patents.

Claims 65-71 recite in different combination the features of the above claims and are supported in the same manners as the above claims in the parent and grandparent patents.

Because as set forth above² each feature of each of the above-referenced claims are supported by the priority documents claiming a priority date prior to that of the Miki reference, the Miki reference is not available for assertion against said claims. Accordingly, as Miki does not qualify as prior art against the present claims, the 102(e) rejection should be withdrawn.

We also note that the Applicants do not bother distinguishing the present claims from the Miki reference on the merits only because the Miki reference does not qualify as prior art. This should in no manner be interpreted as an admission or acquiescence to the arguments set forth by the Examiner in regard to the Miki disclosure as compared to the present claims.

² Which support is also clear from review of the parent, grandparent and great-grandparent priority patents and application.

Claim Rejections Under 35 USC § 103(a)

Claims 13-14 are rejected under 35 USC § 103(a) as allegedly being obvious in view of Miki (US Pat. No. 6,325,081) in combination with and Linn (US 2002/0189640). Applicants traverse these rejections.

As explained above, Miki is not prior art to the present claims under § 102(e) or any other patent statute. Furthermore, for the same reasons as with Miki, neither is Linn prior art to the present claims. Accordingly, the present claims are allowable over the art of reference (whether the art of reference is considered independently or in combination). And as discussed above in relation to the Miki reference, Applicants need not point out the distinguishing features of the present claims over the cited combination of Miki and Linn as these references are not prior art to the present claims.

The Examiner makes further 103(a) rejections to claims 15, 23-24, and 28-30 based on the Miki reference in combination with other references (see the Office action dated October 24, 2005, paras. 11-13). Again, Miki does not qualify as prior art against the present claims. Likewise, the additional cited references Hara (Pat. No. 6,451,696) and Ohkawa (Pat. No. 6,326,657) do not qualify as prior art as they do not have effective dates that predate the priority dates of the present claims. And as discussed above in relation to the Miki reference, Applicants need not point out the distinguishing features of the present claims over the cited combination of references, as these references are not prior art to the present claims.

Applicants believe the present claims are in condition for allowance and notification to that effect is respectfully requested. If the Examiner has any further concerns, the Examiner is invited to contact the undersigned attorney.

Respectfully submitted,

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